



**UNITED STATES DEPARTMENT OF COMMERCE**  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/168,585 10/08/98 DAVIS

F 0001-001(B)

ROBERT G LEV  
4766 MICHIGAN BOULEVARD  
YOUNGSTOWN OH 44505

MM21/0703

EXAMINER

SHAFFER, R

ART UNIT

PAPER NUMBER

2872

DATE MAILED:

07/03/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/168,585

Applicant(s)

DAVIS ET AL

Examiner

R.D. SHAFER

Group Art Unit

2812

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 months MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

☒ Responsive to communication(s) filed on 4/3/01

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

☒ Claim(s) 89-91 is/are pending in the application.

Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 89-91 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement

## Application Papers

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).

☐ All ☐ Some\* ☐ None of the:

☐ Certified copies of the priority documents have been received.

☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_

☐ Copies of the certified copies of the priority documents have been received

in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 19

☐ Interview Summary, PTO-413

☒ Notice of Reference(s) Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Other \_\_\_\_\_

Office Action Summary

Art Unit: 2872

1. The petition to correct the inventorship of this nonprovisional application under 37 CFR 1.48(b) still remains unresolved. It is unclear whether claim 91 is drawn to the inventive subject attributable to Frank Davis or Kenneth R. Harris or to both Frank Davis and Kenneth R. Harris.

Appropriate correction and/or clarification of all the pending claims (claims 89-91) is required.

2. The indicated allowability of claims 89-91 is withdrawn due to the fact that the terminal disclaimer and certification under rule 1.321 & 3.73(b), filed on 11/15/2000 fails to properly disclaim the terminal part of any patent granted on said US Application Serial No. 09/168,585 that would extend beyond the expiration date of U.S. patent No. 5,262,879 and 5,822,092.

Accordingly, the obviousness-type double patenting rejections set forth in Paper No. 12 is reinstated.

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Art Unit: 2872

4. Claims 89-91 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 12 and 16 of U.S. Patent No. 5,262,879. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present application (09/168,585) discloses no additional invention or discovery other than what was already claimed and patented in U.S. patent 5,262,879 or what would have been obvious to one of ordinary skill in the art at the time the invention was made..

5. Claims 89-91 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 2 of U.S. Patent No. 5,822,092. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present application (09/168,585) discloses no additional invention or discovery other than what was already claimed and patented in US Patent 5,822,092 or what would have been obvious to one of ordinary skill in the art at the time the invention was made.

6. Any inquiry concerning this communication should be directed to R. D. Shafer at telephone number (703) 308-4813.

Shafer/ds

06/24/01

*R. D. Shafer*  
RICKY D. SHAFER  
PATENT ATTORNEY  
ART UNIT 2872